

The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.

Paper No. 24

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte JIMMY W. NORMAN

Appeal No. 2003-1390
Application No. 08/989,342

ON BRIEF

Before KRATZ, PAWLIKOWSKI and POTEATE, Administrative Patent Judges.

POTEATE, Administrative Patent Judge.

DECISION ON APPEAL

This is an appeal under 35 U.S.C. § 134 from the examiner's refusal to allow claims 1-24 and 29. Claims 25-28 are also pending but have been withdrawn from consideration as directed to a non-elected invention.

Claims 1, 6, 14, 18 and 29 are representative of the subject matter on appeal and are reproduced below:

1. A template for creating, with mud, a three-dimensional design, other than a design simulating brickwork or stonework, upon a surface, which comprises:

a substantially planar structure which has a thickness equal to a desired depth for one layer of the desired three-dimensional design, such design being other than a design simulating brickwork or stonework, and adequate length and width to accommodate the length and width of the desired design, which is substantially impervious to the mud, and which has one or more apertures that are intended to be filled with mud to create the desired design on the surface.

6. The template for creating, with mud, a three-dimensional design upon a surface as recited in claim 2¹, wherein:

the template is scored to create a section that can be pushed from the template to create an accommodating aperture.

14. The template for creating, with mud, a three-dimensional design upon a surface as recited in claim 1, wherein:

¹Claim 2 reads as follows:

2. The template for creating, with mud, a three-dimensional design upon a surface as recited in claim 1, further comprising:

supports which are of sufficient length to extend from said substantially planar structure, past any previously applied layer of the design, to the surface upon which the original three-dimensional layer is placed and which are so located on the substantially planar structure that said supports will bypass any previously applied layer.

Appeal No. 2003-1390
Application No. 08/989,342

the template has one or more accommodating apertures which are intended to accommodate an object on or rising from the surface and around which the design is desired to be placed.

18. The template for creating, with mud, a three-dimensional design upon a surface as recited in claim 1, wherein:

the template is scored to create a section that can be pushed from the template to create an accommodating aperture.

29. The template for creating, with mud, a three-dimensional design upon a surface as recited in claim 1, wherein:

the template is composed of material selected from the group consisting of fibre board, Plexiglas, and masonite.

The references relied upon by the examiner are:

Budden	3,929,068	Dec. 30, 1975
Lopez	4,129,669	Dec. 12, 1978
Nakanishi	5,389,176	Feb. 14, 1995
Hinkes	5,440,858	Aug. 15, 1995
Hupp	5,487,526	Jan. 30, 1996

Grounds of Rejection²

1. Claims 1, 14-17 and 22-24 stand rejected under 35 U.S.C. § 102(b) as anticipated by Hinkes.
We reverse.

² The rejections of claims 5, 8, 10-13 and 29 under 35 USC § 112, second paragraph, have been withdrawn in view of the amendment (Paper No. 20) filed with appellant's brief (Paper No. 19) on January 10, 2003. See examiner's answer, Paper No. 22, mailed January 29, 2003, page 3.

Appeal No. 2003-1390
Application No. 08/989,342

2. Claims 1, 14-17 and 22-24 stand rejected under 35 U.S.C. § 102(b) as anticipated by Lopez.
We reverse.

3. Claims 1, 14-17 and 22-24 stand rejected under 35 U.S.C. § 102(b) as anticipated by Nakanishi.
We affirm as to claims 1 and 22-24 and reverse as to claims 14-17.

4. Claims 1-5, 9-12 and 14-24 stand rejected under 35 U.S.C. § 102(b) as anticipated by Hupp.
We reverse.

5. Claims 18-21 stand rejected under 35 U.S.C. § 103 as unpatentable over any one of Hinkes, Lopez and Nakanishi in view of Budden.
We reverse.

6. Claims 6-8 and 13 stand rejected under 35 U.S.C. § 103 as unpatentable Hupp in view of Budden.
We reverse.

7. Claim 29 stands rejected under 35 U.S.C. § 103 as unpatentable over any one of Hinkes, Lopez, Hupp and Nakanishi.
We reverse.

Background

The invention relates to a template for creating a three-dimensional design other than a design which simulates brickwork or stonework. Claim 1. The template is shaped to accommodate the surface to which the design is to be applied and may be, for example, flat or curved. Appeal brief, paper no. 19, received January 10, 2003, page 4. The edges of the template may be shaped to accommodate the shape of a structure rising from the

Appeal No. 2003-1390
Application No. 08/989,342

surface on which the design is to be applied. Id.

Alternatively, or in addition, the template may include apertures which accommodate such structures, e.g., a light fixture. Id.

Discussion

Rejections under 35 U.S.C. § 102

A prior art reference anticipates a claim when the reference discloses every feature of the claimed invention, either explicitly or inherently. See Hazani v. United States International Trade Commission, 126 F.3d 1473, 1477, 44 USPQ2d, 1358, 1361 (Fed. Cir. 1997). Anticipation does not require that the reference teach what the appellants are claiming, but only that the claims on appeal "read on" something disclosed in the reference. See Kalman v. Kimberly-Clark Corp., 713 F.2d 760, 772, 218 USPQ 781, 789 (Fed. Cir. 1983), cert denied, 465 U.S. 1026 (1984).

1. Rejection of claims 1, 14-17 and 22-24 under 35 U.S.C. § 102 as anticipated by Hinkes

Appellant argues that Hinkes cannot anticipate the present invention because the template of Hinkes is not designed for creating three-dimensional shapes. Appeal brief, page 13. Rather, Hinkes discloses a template which is designed to create the lines of a game court, which are essentially two-dimensional

Appeal No. 2003-1390
Application No. 08/989,342

markings. Id.

The examiner argues that the molded marks of Hinkes necessarily have some thickness. Examiner's answer, page 16. Thus, giving the claims their broadest reasonable interpretation, the present claims read on Hinkes' template. See id.

Although the examiner is correct that claims are given the broadest reasonable interpretation during patent prosecution, this interpretation must also be consistent with the specification. See In re Yamamoto, 740 F.2d 1569, 1571, 222 USPQ 934, 936 (Fed. Cir. 1984). In reviewing the specification, it is readily apparent that in using the term "two-dimensional design" appellant intends to distinguish over templates used to create symbols, letters and lines such as are used to mark highways and game courts. See specification, page 2, line 8-18. Accordingly, we are in agreement with appellant that a template used to create a two-dimensional marking does not anticipate the claimed template for creating a three-dimensional design.

The rejection is reversed.

2. Rejection of claims 1, 14-17 and 22-24 under 35 U.S.C. § 102 as anticipated by Lopez

Like Hinkes, Lopez is directed to a template for applying two-dimensional markings. See, e.g., Lopez, col. 2, lines 32-34

Appeal No. 2003-1390
Application No. 08/989,342

and 46-50. Accordingly, we are again in agreement with appellant that Lopez does not teach a template for creating a three-dimensional design and, therefore, cannot anticipate the present invention.

The rejection is reversed.

3. Rejection of claims 1, 14-17 and 22-24 under 35 U.S.C. § 102 as anticipated by Nakanishi.

Nakanishi discloses a rugged shaped sheet for use, for example, in forming a lowermost layer of a shoe sole. Appellant argues that Nakanishi utilizes materials such as iron in the template which would "impede maneuverability and tire a worker using such a template" such that Nakanishi's template cannot anticipate the present claims. See appeal brief, pages 18-19.

We do not find appellant's argument persuasive. In making a patentability determination, the relevant inquiry is, "what is the invention *claimed*?" Panduit Corp. v. Dennison Mfg. Co., 810 F.2d 1561, 1567-68, 1 USPQ2d 1593, 1597 (Fed. Cir. 1987), cert denied, 481 U.S. 1052 (1987). "[L]imitations appearing in the specification will not be read into claims, and . . . interpreting what is meant by a word in a claim 'is not to be confused with adding an extraneous limitation appearing in the specification, which is improper.'" In re Cruciferous Sprout

Litigation v. Sunrise Farms, 301 F.3d 1343, 1348, 64 USPQ2d 1202, 1205 (Fed. Cir. 2002) (quoting Intervet Am., Inc. v. Kee-Vet Labs., Inc., 887 F.2d 1050, 1053, 12 USPQ2d 1474, 1476 (Fed. Cir. 1989)). In the present case, the claims simply do not include any limitations relating to the template's weight or materials of construction.

With respect to claims 14-17, appellant additionally argues that Nakanishi's design is between the apertures 36 and not around them as required by these claims. Turning again to the specification, we note that the claim 14 phrase "accommodating apertures which are intended to accommodate an object on or rising from the surface and around which the design is desired to be placed" is used in connection with figure 3. Specification, page 6, lines 22-26. Figure 3 shows the design apertures 2 positioned outside ("around") the perimeter of the accommodating aperture 6.³ Thus, we are in agreement with appellant that interpreting this language as broadly as possible consistent with the specification, the claim does not read on Nakanishi's design.

The rejection is affirmed as to claims 1 and 22-24 and reversed as to claims 14-17.

³Around (adv): "1a: in a circle or in circumference." Webster's Third New International Dictionary 120 (1971).

Appeal No. 2003-1390
Application No. 08/989,342

4. Rejection of claims 1-5, 9-12 and 14-24 under 35 U.S.C. § 102 as anticipated by Hupp.

Appellant argues that Hupp is limited to a template for brickwork or stonework and, therefore, cannot anticipate the claims which require that the template design be in a form other than a design for simulating brickwork or stonework. See appeal brief, page 20 and claim 1. According to the examiner, the claim recitation "such design being other than the design simulating brickwork or stonework" is a statement of intended use and is not significant in determining patentability of an apparatus claim. Examiner's answer, page 13. We disagree.

As drafted, claim 1 recites a template in the form of planar structure having a thickness, length and width which accommodate the desired design. The claim specifies that the desired design is something other than a design which simulates brickwork or stonework. In our view, this statement constitutes a structural limitation wherein the template cannot be constructed in a form which would produce a design simulating brickwork or stonework. Accordingly, we find that this language constitutes more than a mere statement of intended use and is a claim limitation.

The rejection is reversed.

Rejections under 35 U.S.C. § 103.

An invention is unpatentable under 35 U.S.C. § 103 if the claimed invention as a whole would have been obvious to one of

ordinary skill in the art at the time the invention was made. In re O'Farrell, 853 F.2d 894, 902, 7 USPQ2d 1673, 1680 (Fed. Cir. 1988). When an obviousness determination is based on a combination of prior art references, there must be some "teaching, suggestion or incentive supporting the combination." In re Geiger, 815 F.2d 686, 688, 2 USPQ2d 1276, 1278 (Fed. Cir. 1987). "The factual inquiry whether to combine references must be thorough and searching." McGinley v. Franklin Sports, Inc., 262 F.3d 1339, 1351-52, 60 USPQ2d 1001, 1008 (Fed. Cir. 2001).

5. Rejection of claims 18-21 under 35 U.S.C. § 103 as unpatentable over any one of Hinkes, Lopez or Nakanishi in view of Budden

The examiner relies on Budden as disclosing "that the apertures in a template can be formed by cuts through the sheet which cut pieces remain in position in the template at manufacture but are readily removable therefrom (i.e., scoring)." Examiner's answer, page 14. According to the examiner, it would have been obvious to one of ordinary skill in the art to have modified the primary references to include scoring as this would enable formation of apertures that are readily removable pieces from the template. Id.

With respect to the rejections based on Hinkes or Lopez in view of Budden, we note that Budden fails to remedy the deficiency of the primary references in failing to disclose

three-dimensional designs. Accordingly, the rejections of claims 18-21 based on Hinkes or Lopez in view of Budden are reversed.

Turning to the rejection based on Nakanishi in view of Budden, as pointed out by appellant, Budden teaches a sheet having pieces 8 of a required *design* cut therefrom by cuts 9 extending through the layers 2, 3 and 4 which make up the sheet 1 as well as through the adhesive coating 5. Budden, col. 1, lines 57-60. Budden does not disclose or suggest a template which includes *accommodating apertures*. See appeal brief, page 23. The examiner has failed to establish why one of ordinary skill in the art at the time of the invention would have been motivated to have modified the guide holes 36 (accommodating apertures) of Nakanishi to be in the form of scored sections that can be pushed from the template in view of Budden's disclosure which relates to precutting the design itself.

The rejection of claims 18-21 based on Nakanishi in view of Budden is reversed.

6. Rejection of claims 6-8 and 13 under 35 U.S.C. § 103 as unpatentable over Hupp in view of Budden.

Budden relates to a stencil for use when painting designs on surfaces such as walls, applying lettering to signboards or producing pictures on paper or other material. Thus, Budden relates to a two-dimensional, as opposed to a three-dimensional, design. As pointed out above in connection with rejection 4,

Appeal No. 2003-1390
Application No. 08/989,342

Hupp fails to disclose or suggest an apparatus for forming a design other than a design for brickwork or stonework. The examiner has failed to establish how Budden's disclosure would have motivated one of ordinary skill in the art to have modified Hupp to create a template for forming a three-dimensional design simulating something other than brickwork or stonework. The rejection is reversed.

7. Rejection of claim 29 under 35 U.S.C. § 103 as unpatentable over any one of Hinkes, Lopez, Hupp or Nakanishi.

According to the examiner, it would have been obvious to one of ordinary skill in the art at the time of the invention to have modified the apparatuses of the primary references to use fiberboard, wooden fiberboard or blown resin for the template as recited in claim 29. Examiner's answer, pages 15-16. According to the examiner, "[m]ere selection of material known in the art on the basis of suitability for an intended use would be entirely obvious." Id., page 16. Appellant's arguments are limited to his contention that, "[t]he independent patentability of Claim 1 . . . creates the requisite patentability of claim 29 since claim 29 depends on claim 1." Appeal brief, page 24.

With respect to the rejections of claim 29 based on Hinkes, Lopez or Hupp, we find that the examiner has failed to establish why it would have been obvious to one of ordinary skill in the art to have modified the template of Hinkes or Lopez to include

Appeal No. 2003-1390
Application No. 08/989,342

three-dimensional as opposed to two-dimensional designs and to have modified the template of Hupp to include a design other than for brickwork or stonework. Accordingly, the rejections of claim 29 as unpatentable over Hinkes, Hupp or Lopez are reversed.

However, as appellant has failed to dispute the examiner's findings regarding the obviousness of forming a template made of fiberboard, wooden fiberboard or blown resin, and having determined that Nakanishi anticipates claim 1 from which claim 29 depends, we are constrained to affirm the rejection of claim 29 as unpatentable over Nakanishi.

In sum, the rejection of claims 1 and 22-24 under 35 U.S.C. § 102 as anticipated by Nakanishi and the rejection of claim 29 under 35 U.S.C. § 103 as unpatentable over Nakanishi are affirmed. The remaining rejections are reversed.

Appeal No. 2003-1390
Application No. 08/989,342

Time Period for Response

No time period for taking any subsequent action in connection with this appeal may be extended under 37 CFR § 1.136(a).

AFFIRMED-IN-PART

PETER F. KRATZ)	
Administrative Patent Judge)	
)	
)	
)	BOARD OF PATENT
BEVERLY A. PAWLIKOWSKI)	APPEALS AND
Administrative Patent Judge)	INTERFERENCES
)	
)	
)	
LINDA R. POTEATE)	
Administrative Patent Judge)	

LRP/vsh

Appeal No. 2003-1390
Application No. 08/989,342

THOMPSON E. FEHR
SUITE 300
GOLDEN CORPORATE CENTER
5025 ADAMS AVENUE
OGDEN, UT 84403